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EXAMINER

TRINH, SONNY

ART UNIT PAPER NUMBER

2687

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/838,951

Applicant(s)

CHI, LIANG-YU

Examiner

Sonny TRINH

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14-16, 34, 35 and 38-40 is/are allowed.
- 6) ☒ Claim(s) 1-13, 17-28, 30-33, 36, 37 and 41-43 is/are rejected.
- 7) ☒ Claim(s) 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

In response to applicant's argument that Vanden Heuvel is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

In this case, Applicant attempted to overcome the Vanden Heuvel's reference by stating that "...Applicant respectfully disagrees with the office assertion that Vanden Heuvel teaches "associating the first indication on the display with a user-defined external state". As explained in previous communications, mere display of a screen information, as described in the passage cited in the Office Action (abstract; column 2 lines, 27 to 59) does not constitute "establishing an association", as taught by Applicant. Elsewhere in the reference (col. 5, lines 48 to 60, especially lines 54 through 57) Vanden Heuvel teaches use of icons (206a, 206b, 206c) to "indicate that three screens have been pre-selected by the user for display during quick view operation." This passage speaks of a relationship between the number of external states selected and the number of icons displayed rather than the association of a particular external state with a particular indication on the display. As further clarified in the reference (column 8, lines 5 through 9), a screen may be automatically inserted as a quick view in response

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to a trigger, in which case the flag shaped screen icons 206d indicates that a fourth screen has automatically been inserted for quick view display” (col. 5, lines 57-59). Given that a large number of screens may be inserted, the flag icon may refer to a number of automatically inserted external states. In addition, given a limitation on the number of entries available, e.g., twenty in a preferred embodiment, deletion and insertion operations will necessarily reassign certain triangles 206 to different external states...”

However, as clearly pointed out by the Examiner in the Office Action, the step of “associating a first indication on the display with a user defined external state” specifies by claim 1 is no more than a flag set by the user (column 2, ll. 18-42) to associate a particular information of interest such as financial, sports, news (column 3, ll. 63-68). Once the flag is set, anytime the selective call receiver receives a message, it updates a portion of the database in response to the update information, control circuitry within the selective call receiver provides user activation of a quick view mode of operation clearly indicates that there is an association with a user defined states as claimed (please see column 3, ll. 43-68).

Therefore, the Examiner is not convinced by Applicant’s arguments that Vanden Heuvel does not disclose each and every element of claim 1.

Regarding claims 3, 15, 25, 31, Applicant presented the same arguments as indicated as presented in the argument of claim 1 above (specifically about the “user specified” indication on the display), Vaden Heuvel clearly teaches the setting of the flag (i.e. “associating” an event with the display) as presented by Examiner in above

paragraphs. Therefore, the Examiner is not convinced that Vanden Heuvel (alone or in combination with other references cited by the Examiner) does not teach the step of "associating a first user specified indication on the display with a user defined state" as claimed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claims 1-8, 11, 13, 18-19, 25-27, 30-33, 41-43** are rejected under 35 U.S.C. 102(b) as being anticipated by Vandel Heuvel et al. (hereinafter "Vandel"; U.S. Patent Number 5,426,422).

Regarding **claim 1**, Vandel teaches a method of presenting information on space constrained of a portable device (abstract, column 1 lines 43-47), the method comprising:

associating a first user specified indication on the display with a user-defined external state (abstract, see column 2, specifically lines 27-59); establishing a user-defined operation for monitoring the user-defined external state (figure 9, the user can flag a screen, see abstract, column 2 lines 27-59); and updating the first indication on the display in accordance with the monitored user-defined external state in response to

an information encoding thereof received via a telecommunications network (abstract, column 2 line 27-59, abstract).

Regarding **claim 2**, Vandel further teaches that the user-defined external state is a system or information status state (stocks information (figures 9, 13, 14)).

Regarding **claim 3**, Vandel teaches a method of presenting information on a space-constrained display of a portable device (abstract, column 1 lines 43-47), the method comprising:

- associating a first user specified indication on the display with a user-defined external state (by flagging the desired information (see abstract, column 2 lines 18-42);

- establishing a user-defined operation for monitoring the user-defined external state (see abstract, column 2 lines 18-42);

- updating the first indication on the display in accordance with the monitored user-defined external state in response to an information encoding thereof received via a telecommunications network (see figure 9 and column 7 line 60 to column 8 line 9);
- performing the established user-defined operation using a networked computational service remote from the portable device (see figure 9 and column 7 line 60 to column 8 line 9); and

- supplying the information encoding in correspondence with a result of the performed user-defined operation (abstract, column 2 lines 18-42, see figure 9 and column 7 line 60 to column 8 line 9).

Regarding **claim 4**, Vandel further teaches wherein the supplying includes pushing the information encoding to the portable device via the telecommunications

network (figure 9, column 3 line 62-68, information such as News, Sports, Stocks are obviously pushed from the network).

Regarding **claim 5**, Vandel further teaches that the supplying of the information is in response to a request from the portable device (abstract, column 2).

Regarding **claim 6**, Vandel further teaches that the step of retrieving from a networked computational service remote from the portable device, an information encoding in correspondence with a result of the performed user-defined operation (columns 5-6, specifically line 48-60 of column 5 and lines 56-68 of column 6, see also abstract).

Regarding **claims 7-8**, Vandel further teaches that the user-defined external state is selected from amongst a predetermined set of external states available for monitoring (such as financial, sports, News (column 3, lines 63-68) and inherently selected from amongst a predetermined set of at least partially-predefined queries.

Regarding **claim 11**, Vandel further teaches that the associating of the first indication with the user defined external state and the establishing of the user-defined operation are performed via the portable device (abstract, column 2 lines 18-42).

Regarding **claim 13**, Vandel further teaches that the first indication is a graphical indication (see for example figure 9, user defined flag 325).

Regarding **claim 18**, Vandel further teaches that the portable device is a pager (abstract, figure 9).

Regarding **claim 19**, Vandel further teaches that the telecommunications network transmission and routing facilities include a wireless data network (inherent for a paging system).

Regarding **claims 25-27**, these 3 claims combined reflect the computer program necessary for performing the steps as specified in claim 1 and is therefore rejected for the same reasons.

Regarding **claim 30**, it is inherent that the computer program product is selected from an electronic storage medium, Vandel discloses a communication network for delivering data such as stock prices, news, weather to the portable pager (abstract).

Regarding **claims 31-32**, these 2 claims combined merely reflect the means necessary for performing the steps as specified in claim 1 and are therefore rejected for the same reasons.

Regarding **claim 33**, Vandel further teaches a user defined operation / selection (abstract, column 2 lines 18-42).

Regarding **claims 41-42**, Vandel further teaches that the user specified indication is selected from amongst a predetermined set of indications and is user defined (column 2, ll. 43-69)

Regarding **claim 43**, Vandel further teaches that the user specified indication comprises a user specified portion of the display (abstract, claim 3, column 4, line 62 to column 5 line 13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 9-10, 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vandel in view of Harui ("Harui" U.S. Patent Number 6,690,394).

Regarding **claims 9-10**, Vandel discloses the invention but does not disclose that the associating of the first indication with the user-defined external state is performed without use of the portable device.

In an analogous art, Harui teaches the method and apparatus for delivering WEB data to a wireless device (abstract). Harui further teaches that a user can specify the amount of information and how often to send that information to a mobile communication device (figures 3-4, see descriptions) which inherently indicates that the use of the portable device is not needed for the request of information and the establishing of the user-defined operation is performed without use of the portable device.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, within the system of Vandel, the step of using networked computational service remote from the portable device, as taught by Harui, to eliminate the need for having a browser on the portable device to save time and

memory by allowing the user to specify the information to be delivered to the wireless device at a computational device such as a computer connected to the internet.

Regarding **claim 12**, Harui further teaches that the user-defined operation includes a query executable at a networked computational service remote from the portable device (figures 1,3-4, see descriptions).

3. **Claims 17, 36-37** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vandel.

Regarding **claim 17**, Vandel discloses the invention but does not explicitly disclose that the display device includes a two-dimensional array of display elements suitable for simultaneously presenting plural visual indications displaced throughout at least a portion thereof. However, portable device such as telephone with plurality of displays is well known and widely used in the wireless communication field and the Examiner takes Official notice of such use in order to provide to the user additional information that one display normally cannot provide.

Regarding **claims 36-37**, Vandel discloses the invention but does not explicitly disclose that the first indication is a graphical indication representing one of at least two states nor the graphical indication is a binary indicator. However, since Vandel teaches that different data can be downloaded to the portable device (see abstract, column 2, column 3 lines 43-67), it is obvious and well within the level of a person of ordinary skill in the art to present the indication to the user in different states such as binary indicator, by using only binary information, the information presented can be minimized, resulting in space savings.

4. **Claims 20-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vandel in view of Yamamoto ("Yamamoto" U.S. Patent Number 6,297,9454).

Regarding **claim 20**, with reference to figures 1-3, 9, 13, 14 and descriptions, Vandel discloses a portable device comprising :

a space-constrained display (see column 1 lines 43-47) with a communications interface to a telecommunications network (figure), the communications interface coupled to the space-constrained display (figure 1, see display 42) and allowing the portable device to receive information encoding one or more external states and to update respective ones of the visual indications based on respective user-defined associations with the external states (abstract, column 2).

However, Vandel does not disclose that the portable device including a two-dimensional array of display elements suitable for simultaneously presenting plural visual indications displaced throughout at least a portion thereof.

In an analogous art, Yamamoto teaches a portable electronic terminal apparatus having a plurality of displays (see figures 4, 7, 9, 11 and descriptions in columns 1-4).

Since both Vandel and Yamamoto relates to portable devices with different ways of presenting information to the user via display, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to use, within the mobile terminal of Armstrong, the multiple displays, as taught by Yamamoto, in order to present more information to the user without having to perform complex manipulation to the display.

Regarding **claim 21**, Vandel further discloses the external states are user selected such as financial, Sports, News (column 3, lines 62-68).

Regarding **claim 22**, Yamamoto further teaches that the plural visual indications are grouped based on correspondence of the associated external states (column 4, specifically lines 19-24).

Regarding **claim 23**, Vandel further teaches that the telecommunications network includes a wireless data network (paging network, figure 1, see description).

Regarding **claim 24**, Vandel further teaches that the portable device embodied as a pager (figures 1-3).

5. **Claims 28** is rejected under 35 U.S.C. 103(a) as being unpatentable over Vandel in view of Makipaa et al. ("Makipaa" U.S. Patent Number 6,556,217 B1).

Regarding **claim 28**, Vandel discloses the invention but does not disclose the information server that accesses one or more data stores in which results of monitoring of the user defined external states are encoded.

In an analogous art, Makipaa teaches a system and method for content adaptation and pagination based on terminal capabilities. Makipaa further teaches the information server for storing different information such as stock exchange, commodities market, sports etc. (figure 1, content server 20, column 4 line 39 to line 15 of column 5).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to combine the information server, as taught by Makipaa,

with the system of Vandel, in order to provide the desired information and display it according to the user selections.

Allowable Subject Matter

6. **Claims 14-16, 34-35, 38-40** are allowed.

Claims 14-15 have been rewritten in independent forms including the objected limitations raised by the Examiner in the previous Office action and are therefore allowable.

Claim 29 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding **claim 29**, the prior art provided numerous examples of presenting data to the user with space constrained display, but failed to disclose or fairly suggest the specific combination of structural and functional limitations set forth in claim 29, specifically, wherein the first functional sequence is embodied at least in part as code implementing a web page accessible from either or both of the portable device and a networked computer.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sonny TRINH whose telephone number is 571-272-7927. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester KINCAID can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11/28/05


SONNY TRINH
PRIMARY EXAMINER